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In re Application :  
Rosen et al.  
Application No. 09/833,041  
Filed: April 12, 2001  
Atty Docket No. 6832.0016

: DECISION ON APPLICATION  
: FOR PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT" filed October 19, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from four hundred two (402) days to four hundred eighteen (418) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein. For the reasons set forth herein, the initial determination of 402 days of patent term adjustment is correct.

On February 20, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 402 days. The period of adjustment of 418 days for Office delay was reduced by 16 days for applicant delay. On October 19, 2004, applicants timely<sup>1</sup> submitted an application for patent term adjustment (with required fee). Applicants dispute the reduction of 16 days attributed to delay in responding to the Notice to File Missing Parts of Application mailed June 8, 2001.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

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<sup>1</sup> PALM records indicate that the Issue Fee was also received in the Office on October 19, 2004.

As to the 16 day delay entered by the Office, applicants are correct. Their response to the Notice to File Missing Parts of Application mailed June 8, 2001, is of record in the application with a date of receipt by the Office of August 8, 2001. Furthermore, the response included a complete reply to the Notice. Thus, the Office should not have assessed applicants a delay of 16 days. The response was filed within the three-month period under 37 CFR 1.704(b). Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application.

However, a review of the application history reveals the basis for the entry of an additional period of reduction. Pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. After filing the Request for Continued Examination (RCE) and amendment on May 18, 2004, on June 3, 2004, applicants filed a supplemental response. The record does not support a conclusion that this response was expressly requested by the examiner. Accordingly, the PTA should be reduced by 16 days, the number of days beginning on the day after the date the reply was filed, May 19, 2004, and ending on the date that the supplemental reply was filed, June 3, 2004.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is four hundred two (402) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will forward the file to the Office of Patent Publication so that a patent can be issued.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

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